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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,446	02/23/2005	Alan John Johnstone	8830-316 (207300)	3858
7590 Gregory J Lavorgna Drinker Biddle & Reath One Logan Square 18th and Cherry Streets Philadelphia, PA 19103				
04/24/2009				
EXAMINER				
PRONE, CHRISTOPHER D				
ART UNIT		PAPER NUMBER		
3738				
MAIL DATE		DELIVERY MODE		
04/24/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/525,446

**Applicant(s)**

JOHNSTONE ET AL.

**Examiner**

CHRISTOPHER D. PRONE

**Art Unit**

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 10-26, 28-30 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) 23, 30, 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-22, 24-26, 28, 29, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-12, 14-22, 31, 34, and 35 are rejected under 35 U.S.C. 103 as being unpatentable over Fixel et al. United States Patent 3,990,116 in view of Birbeau Foreign Publication FR 2 724 309 A1.

Fixel discloses the invention substantially as claimed being an implantable replacement joint comprising first and second components 32 and 34 adapted to form an interference fit to bone and free floating flexible component 17 that extends into a cavity in first and second components. Fixel further discloses that the first and second components comprise bearing surfaces having convex bearing surfaces that the flexible component and bores extend through shown best in figure 5.

In regards to claims 14-17, Fixel discloses an embodiment shown in figure 2 where the first and second components are pivotable around a plurality of axis including perpendicular ones.

In regards to claims 18-22, Fixel discloses the first and second components are made from metal alloys and that the flexible member is made from silicone rubber.

However Fixel fails to disclose that the flexible member smaller than the bore and that it is free to float and more.

Birbeau teaches the use of implantable joint comprising first and second attachment components 4 and 6 connected by a member 8 that is smaller than bores 22 and 24 in the same field of endeavor for the purpose of providing a secure implant with a full range of motion. In regards to lateral and axial movement the bore shown in figures 2-5 is larger than member 30 so it will inherently allow at least some lateral and axial movement.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the oversized bore as taught by Birbeau with the device of Fixel in order to an increased range of motion.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fixel as modified by Birbeau as applied to claims 1-5, 8-12, 14-22, 31, 34, and 35 above, and further in view of Vitale United States Patent 5,683,466.

The Fixel combination discloses the invention substantially as claimed being described supra. However, the combination does not disclose screw threads on the outside bone engaging surfaces of the first and second components.

Vitale teaches the use of screw threads on the outside bone engaging surfaces of the first and second components in the same field of endeavor for the purpose of providing a secure anchor.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the screw threads on the outside bone engaging

surfaces of the first and second components with the device of Fixel in order to provide a secure anchor.

Claims 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fixel as modified by Birbeau as applied to claims 1-5, 8-12, 14-22, 31, 34, and 35 above, and further in view of Huebner United States Patent 5,702,472.

The Fixel combination discloses the invention substantially as claimed being described supra. However, the combination does not disclose use of a spacer component placed between the first and second components.

Huebner teaches the use of a spacer component comprising an arcuate surface and multiple pivot points in the same field of endeavor for the purpose of resisting wear and tear during normal flexation of the implant.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the spacer of Huebner with the implant of Fixel in order to resist wear and tear during normal flexation of the implant.

### ***Response to Arguments***

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHRISTOPHER D. PRONE** whose telephone number is (571)272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

/Christopher D Prone/

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738